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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,073	11/25/2003	James V. Leonard	BOEI-1-1205	4169

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EXAMINER

AHLUWALIA, NAVNEET K

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,073	Applicant(s) LEONARD ET AL.	
	Examiner Navneet K. Ahluwalia	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The application has been examined. Claims 1 – 7 and 15 – 28 are pending in this office action.

Response to Arguments

2. Applicant's arguments with respect to claims 1 – 7 and 15 – 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22 – 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The computer readable media itself cannot perform an action or a method, therefore it is not clearly understood how the computer readable media would perform the method of claims 1 – 7 for claims 22 – 28 respectively. Thus these claims and their functionality are not enabling.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 22 – 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The computer readable media itself cannot perform an action or a method, therefore it is not clearly understood how the computer readable media would perform the method of claims 1 – 7 for claims 22 – 28 respectively. Thus these claims and their functionality are vague and indefinite.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 – 7 and 15 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colson et al. ('Colson' herein after) (US 2002/0072997 A1) further in view of Matthew Comroe ('Comroe' herein after) (US 2001/0047362 A1).

With respect to claim 1,

Colson discloses a method for augmenting an internal library with published submissions to a technical society, the method comprising:

- locating an abstract for a published submission on a technical society website (Figure 1, paragraph 0009, Colson);
- downloading the abstract for the published submission to a machine-readable memory medium at a first address (Figure 1, paragraphs 0009 – 0010, Colson);
- locating the published submission on a technical society website (Figure 1, paragraphs 0009 – 0010 and 0057, Colson);
- downloading the published submission to the machine-readable memory medium at a second address (paragraphs 0061 – 0062 and 0073, Colson);
and
- embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked (Figures 20, 20B and paragraphs 0080 – 0082, Colson).

Colson however does not disclose embedding the hyperlink in the abstract for the full text explicitly as claimed. Instead it teaches embedded hyperlink in the product document number for the document.

Comroe teaches the hyperlink being embedded in the title for the full text document (paragraph 0050, Comroe). It would be inherent that the hyperlink can be embedded in the abstract for the full text to the article.

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because it would enhance Colson's method of publication website to be searched for documents/articles and other objects by keywords, text, category, abstract, headlines and also further provide the viewable format of the document by providing a hyperlink (paragraph 0007 – 0017, Comroe). Furthermore it would be more convenient for the clients to search and download information by just clicking on the link once suitable information was found.

10. Claims 2 – 7 are rejected under the same rationale given for claim 1. The citations of the elements claimed and taught are listed below.

With respect to claim 2,

Colson discloses the method of claim 1, wherein locating the abstract is based upon a submission approval procedure internal to an organization (it is inherent that if the abstract and documents are found, they would have been submitted at a certain

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point in time to an organization paragraphs 0080 – 0082, Colson and paragraph 0050, Comroe).

With respect to claim 3,

Colson discloses the method of claim 2, wherein locating the submission is based upon a submission approval procedure internal to an organization (it is inherent that if the documents are found, they would have been submitted at a certain point in time to an organization paragraphs 0080 – 0082, Colson and paragraph 0050, Comroe).

With respect to claim 4,

Comroe discloses the method of claim 1, wherein the downloading of the abstract includes indexing the first address to allow searching for the abstract (paragraph 0010, Comroe).

With respect to claim 5,

Comroe discloses the method of claim 4, wherein the searching is by keyword (paragraph 0050, Comroe).

With respect to claim 6,

Comroe discloses the method of claim 4, wherein the searching is by subject (paragraphs 0010 and 0050, Comroe).

With respect to claim 7,

Comroe discloses the method of claim 4, wherein the searching is by author (paragraphs 0007 – 0014, Comroe).

With respect to claim 15,

Colson discloses a system for augmenting an internal library with published submissions to a technical society, the method comprising:

- a first means for locating an abstract for a published submission on a technical society website (Figure 1, paragraph 0009, Colson);
- a second means for downloading the abstract for the published submission to a machine-readable memory medium at a first address (Figure 1, paragraphs 0009 – 0010, Colson);
- a third means for locating the published submission on a technical society website (Figure 1, paragraphs 0009 – 0010 and 0057, Colson);
- a fourth means for downloading the published submission to the machine-readable memory medium at a second address (paragraphs 0061 – 0062 and 0073, Colson); and
- a fifth means for embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked (Figures 20, 20B and paragraphs 0080 – 0082, Colson).

Colson however does not disclose embedding the hyperlink in the abstract for the full text explicitly as claimed. Instead it teaches embedded hyperlink in the product document number for the document.

Comroe teaches the hyperlink being embedded in the title for the full text document (paragraph 0050, Comroe). It would be inherent that the hyperlink can be embedded in the abstract for the full text to the article.

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of cited references because it would enhance Colson's system of publication website to be searched for documents/articles and other objects by keywords, text, category, abstract, headlines and also further provide the viewable format of the document by providing a hyperlink (paragraph 0007 – 0017, Comroe). Furthermore it would be more convenient for the clients to search and download information by just clicking on the link once suitable information was found.

11. Claims 16 – 21 are rejected under the same rationale given for claim 15. The citations of the elements claimed and taught are listed below.

With respect to claim 16,

Colson discloses the system of claim 15, wherein locating the abstract is based upon a submission approval procedure internal to an organization (it is inherent that if the abstract and documents are found, they would have been submitted at a certain

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point in time to an organization paragraphs 0080 – 0082, Colson and paragraph 0050, Comroe).

With respect to claim 17,

Colson discloses the system of claim 16, wherein locating the submission is based upon a submission approval procedure internal to an organization (it is inherent that if the documents are found, they would have been submitted at a certain point in time to an organization paragraphs 0080 – 0082, Colson and paragraph 0050, Comroe).

With respect to claim 18,

Colson discloses the system of claim 15, wherein the downloading of the abstract includes indexing the first address to allow searching for the abstract (paragraph 0010, Comroe).

With respect to claim 19,

Colson discloses the system of claim 18, wherein the searching is by keyword (paragraph 0050, Comroe).

With respect to claim 20,

Colson discloses the system of claim 18, wherein the searching is by subject (paragraphs 0010 and 0050, Comroe).

With respect to claim 21,

Colson discloses the system of claim 18, wherein the searching is by author (paragraphs 0007 – 0014, Comroe).

With respect to claim 22,

Computer readable media that performs the method of claim 1 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 1).

With respect to claim 23,

Computer readable media that performs the method of claim 2 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 2).

With respect to claim 24,

Computer readable media that performs the method of claim 3 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 3).

With respect to claim 25,

Computer readable media that performs the method of claim 4 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 4).

With respect to claim 26,

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Computer readable media that performs the method of claim 5 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 5).

With respect to claim 27,

Computer readable media that performs the method of claim 6 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 6).

With respect to claim 28,

Computer readable media that performs the method of claim 7 (See rejections under 35 USC 112 1st, 2nd and rejection for claim 7).


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navneet K. Ahluwalia whose telephone number is 571-272-5636. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam T. Hosain can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Navneet K. Ahluwalia
Examiner
Art Unit 2166


MOHAMMAD ALI
PRIMARY EXAMINER

Dated: 09/21/2006